

**REMARKS**

Claims 1-10 are pending.

At page 2 of the Action, Claims 1-3 and 5-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-19 of co-pending Application No. 10/543,892.

Applicants submit that this rejection should be withdrawn because the present claims are not obvious over the claims of co-pending '892 application. The present claims are directed to fine particles which have as an essential element "a functional group on the particle surface." In contrast, the claims of the co-pending '892 application do not recite this essential element.

At page 3 of the Action, claims 1-3 and 6 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Davies et al (US 4,177,253).

At page 4 of the Action, claims 4-5, 8 and 10 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Davies et al.

Applicants submit that these two rejections should be withdrawn because Davies et al does not disclose or render obvious the present invention.

Davies et al discloses composite magnetic particles comprising a low density core and having a magnetic coating over at least a portion of the surface of the core. In Examples 1 to 8 of Davies et al, cobalt or nickel coating was carried out on the entire surface of hollow glass spheres or polypropylene spheres.

In contrast, the magnetic material is contained within the polymer fine particles in the present invention. Therefore, Davis et al and the present invention are mutually exclusive with each other with respect to the location of the filler or the magnetic material.

Further, incorporation of functional groups is much easier in the present invention (page 5, line 15 to page 8, line 10 of the present specification). Specifically, various methods can be employed to incorporate functional groups into the spherical polymer fine particles of the present invention, such as a surface graft polymerization method (page 5, lines 17-27 of the specification), an alkaline hydrolysis (the first full paragraph at page 6 of the specification) and an addition of higher fatty acids (the second full paragraph at page 6 of the specification).

These methods cannot be applied to surface metal-coated fine particles of Davies et al. In an acidic solution, metal-coated fine particles of Davies et al cannot be used because metal may be dissolved out.

In contrast, spherical polymer fine particles of the present invention are inert even in acidic solution, because the magnetic material is contained within the polymer fine particles.

Still further, Davies et al discloses core polymers containing reactive groups or comprising a three dimensional network at col. 6, lines 50-57. In the present invention, functional groups are located on the surface of the fine particles and not in the core polymer.

The present invention provides fine particles that are resistant to setting and have on the surface a highly reactive functional group. See page 3, lines 5-4 up from the bottom of the specification.

Davies et al does not teach or suggest the effects of the present invention.

Therefore, the present claims are not anticipated by, nor obvious over, Davies et al. Reconsideration and withdrawal of the §§102(b)/103(a) rejections based on Davies et al are respectfully requested.

At page 6 of the Action, claims 7 and 9 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Davies et al in view of Goldman et al (US 4,097,392).

Applicants submit that this rejection should be withdrawn for at least the same reasons that the previous rejections of claims 1-6, 8 and 10 based on Davies et al should be withdrawn, as discussed above, since Goldman does not make up for the deficiencies of Davies. Further, there is no good reasoning to combine Davies et al and Goldman et al.

Allowance is respectfully requested. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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